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Docket No.: 58071-CON/RCE (47126)  
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of: Gregor Cevc

Application No.: 09/621,574 - Conf. No.: 5661

Art Unit: 1615

Filed: July 21, 2000

Examiner: G. S. Kishore

For: PREPARATION FOR THE APPLICATION OF AGENTS IN MINI-DROPLETS

MAIL STOP: AMENDMENT

Commissioner for Patent

P.O. Box 1450

Alexandria, VA 22313-1450

**PETITION UNDER 37 C.F.R. §1.182 TO WITHDRAW EFFECT OF TERMINAL  
DISCLAIMER IN PRESENT APPLICATION**

Applicants hereby Petition under 37 C.F.R. §1.182 to withdraw any effect of the terminal disclaimer filed in U.S.S.N. 07/844,664 on the present application (U.S.S.N. 09/621,574).

1. On April 8, 1992, Applicant filed a United States National Application based on PCTEP91/01596. The PCT application was filed on August 22, 1991 and claimed a priority date of August 24, 1990. The United States National Application received United States Serial Number 07/844,664 (hereinafter referred to as U.S.S.N. 07/844,664).
2. On June 25, 1992, U.S.S.N. 07/844,664 became abandoned under 37 CFR §1.494. While Applicant submitted 149 pages of translated specification, 10 pages of translated claims, and a translated abstract, Applicant inadvertently did not translate the graph headings in the drawings from German to English prior to June 25, 1992.
3. On August 20, 1992, the U.S.P.T.O. mailed Applicant's former counsel (hereinafter Merchant & Gould) a Notification of Abandonment.

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Dated: July 20, 2005

Signature: *Lakeisha Bryant*

(Lakeisha Bryant)

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4. Due to a docketing error, the Notification of Abandonment was not entered into the Merchant & Gould docketing system.

5. On December 9, 1994, the Merchant & Gould Docketing Department became aware of a problem with U.S.S.N. 07/844,664.

6. On February 15, 1995, Applicant filed a Petition under Rule 1.137(a) and/or 1.183 to revive U.S.S.N. 07/844,664. A Terminal Disclaimer was filed together with the Petition disclaiming "the terminal part of any patent granted on the above-identified application equal to the period of abandonment of this application."

7. On June 22, 1995, the Office of Petitions mailed a Decision On Petition in which Applicant's petition was dismissed due to inadequate showing of unavoidable delay. The Office of Petitions further asserted that the Terminal Disclaimer filed on February 15, 1995 was not in compliance with 37 C.F.R. §1.137 because it lacked a statement that "this terminal disclaimer applies to any patent granted on the above-identified application or on any application which is entitled to the benefit of the filing date of the application under 35 U.S.C. 120."

8. According to 37 C.F.R. 1.137(d)(1) "Any petition to revive pursuant to this section in either a utility or plant application filed before June 8, 1995, must be accompanied by a terminal disclaimer and fee as set forth in § 1.321". Further, according to 37 CFR §1.137(d)(2) "Any terminal disclaimer pursuant to paragraph (d)(1) of this section must also apply to any patent granted on a continuing utility or plant application filed before June 8, 1995". Thus, the Office of Petitions was in error in asserting that the Terminal Disclaimer, according to 37 C.F.R. §1.137, required a statement that "this terminal disclaimer applies to any patent granted on the above-identified application or on any application which is entitled to the benefit of the filing date of the application under 35 U.S.C. 120." Rather, according to 37 C.F.R. §1.137, the terminal disclaimer must only apply to any patent granted on a continuing utility application filed before June 8, 1995. However, this portion of the Rule was not taken into consideration by the Office, which, instead required that the terminal disclaimer apply to all continuing applications regardless of their filing date.

8. On October 23, 1995, Applicant filed a Renewed Petition Under 37 CFR §1.137(a) to revive U.S.S.N. 07/844,664. Applicant apparently did not recognize the Office's error in applying 37 C.F.R. §1.137(d)(2) and, thus, filed with their Renewed Petition, a new Terminal Disclaimer that included the wording required by the Office of Petitions.

9. On January 23, 1996, the Office of Petitions mailed a Decision On Petition in which Applicant's petition was dismissed because Applicant's Renewed Petition did not include an adequate verified showing of the cause of unavoidable delay and a terminal disclaimer and fee.

10. On April 23, 1996, Applicant filed a second Renewed Petition Under 37 CFR §1.137(a) to revive U.S.S.N. 07/844,664. Within the second Renewed Petition, Applicant provided further information regarding the unavoidable delay and noted that a terminal disclaimer and fee were, in fact, submitted with the October 23, 1995 petition.

11. On June 26, 1996, the Office of Petitions mailed a Decision granting Applicant's Petition. The Decision noted that the "Terminal Disclaimer filed on October 26, 1995 has been accepted."

12. On February 26, 1999, during the course of prosecution of U.S.S.N. 07/844,664, Applicants filed a Continued Prosecution Application (CPA). Because the CPA was filed after June 8, 1995, according to 37 C.F.R. §1.137(d)(2), the previously filed terminal disclaimer should not have been required to apply to the continuing application.

13. On December 26, 2000, U.S.S.N. 07/844,664 issued as Patent Number 6,165,500. On the cover page of the patent, it is stated that "[t]his patent is subject to a terminal disclaimer."

14. On December 12, 2002, Applicant filed a petition requesting removal of the indication on Patent Number 6,165,500 that "[t]his patent is subject to a terminal disclaimer".

15. On December 22, 2003, the Office of Petitions mailed a Decision denying Applicant's petition to remove the terminal disclaimer from the issued patent. In the Decision, the Office stated that "the terminal disclaimer captioned for and accepted in prior application 07/844,664

automatically remained recorded against the CPA having the same application number." The Office further stated that "once a patent issues, the USPTO will not remove the effect of a recorded terminal disclaimer" and that "petitioner did not seek to mitigate the effect of the recorded terminal disclaimer during the pendency of the CPA."

16. On July 21, 2000, Applicant filed the present continuation application, which received U.S.S.N. 09/621,574 and a filing date of July 21, 2000.

#### RELIEF REQUESTED

Applicant requests that any effect of the Terminal Disclaimer filed for U.S.S.N. 07/844,664 on the present application (U.S.S.N. 09/621,574) be withdrawn. Applicant respectfully submits that the Office erroneously applied 37 C.F.R. §1.137 by requiring that Applicant amend their February 15, 1995 Terminal Disclaimer to broadly state that "this terminal disclaimer applies to \* \* \* any application which is entitled to the benefit of the filing date of the application under 35 U.S.C. 120." According to 37 C.F.R. §1.137(d)(1), "[a]ny petition to revive pursuant to this section in either a utility or plant application filed before June 8, 1995, must be accompanied by a terminal disclaimer." Further, according to 37 C.F.R. §1.137(d)(2) "Any terminal disclaimer pursuant to paragraph (d)(1) of this section must also apply to any patent granted on a continuing utility or plant application filed before June 8, 1995". Thus, the requisite time period set forth in 37 C.F.R. §1.137(d)(2) was not properly taken into account.

The present continuation application U.S.S.N. 09/621,574 was filed on July 21, 2000. Because the filing date of U.S.S.N. 09/621,574 falls after the date set forth in 37 C.F.R. §1.137(d)(2), the Office should not have mandated that Terminal Disclaimer filed in U.S.S.N. 07/844,664 apply to "any application which is entitled to the benefit of the filing date of the application under 35 U.S.C. 120." Rather, 37 C.F.R. §1.137(d)(2) requires only that such Terminal Disclaimers apply to continuing applications filed before June 8, 1995. This clearly is not the case with U.S.S.N. 09/621,574.

CONCLUSION

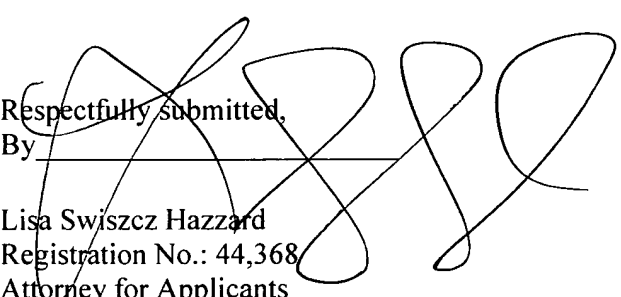
For at least the above reasons, Applicants urge that the October 23, 1995 Terminal Disclaimer, filed for U.S.S.N. 07/844,664, not apply to the present application.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 04-1105, under Order No. 58071 (47126). A duplicate copy of this paper is enclosed.

If a telephone conversation with Applicants' attorney would expedite consideration and granting of this position, the Commissioner is invited to contact the undersigned at the telephone number indicated below.

Dated: July 20, 2005

Respectfully submitted,  
By \_\_\_\_\_



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PTO/SB/21 (09-04)

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# TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	09/621,574-Conf. #5661	
	Filing Date	July 21, 2000	
	First Named Inventor	Gregor Cevc	
	Art Unit	1615	
	Examiner Name	G. S. Kishore	
Total Number of Pages in This Submission	8	Attorney Docket Number	58071-CON/RCE (47126)

## ENCLOSURES (Check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form  <input type="checkbox"/> Fee Attached  <input type="checkbox"/> Amendment/Reply  <input type="checkbox"/> After Final  <input type="checkbox"/> Affidavits/declaration(s)  <input type="checkbox"/> Extension of Time Request  <input type="checkbox"/> Express Abandonment Request  <input type="checkbox"/> Information Disclosure Statement  <input type="checkbox"/> Certified Copy of Priority Document(s)  <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application  <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s)  <input type="checkbox"/> Licensing-related Papers  <input checked="" type="checkbox"/> Petition  <input type="checkbox"/> Petition to Convert to a Provisional Application  <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address  <input type="checkbox"/> Terminal Disclaimer  <input type="checkbox"/> Request for Refund  <input type="checkbox"/> CD, Number of CD(s) _____  <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC  <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences  <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)  <input type="checkbox"/> Proprietary Information  <input type="checkbox"/> Status Letter  <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Return Receipt Postcard
<b>Remarks</b>		

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

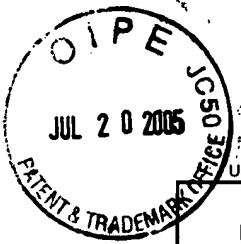
Firm Name	EDWARDS & ANGELL LLP		
Signature			
Printed name	Lisa Swiszc Hazzard		
Date	July 20, 2005	Reg. No.	44,368

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Dated: July 20, 2005

Signature: (Lakeisha Bryant)



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<b>PETITION FEE</b> <b>Under 37 CFR 1.17(f), (g) &amp; (h)</b> <b>TRANSMITTAL</b> (Fees are subject to annual revision)		
<b>Send completed form to:</b> Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	<b>Application Number</b>	09/621,574-Conf. #5661
	<b>Filing Date</b>	July 21, 2000
	<b>First Named Inventor</b>	Gregor Cevc
	<b>Art Unit</b>	1615
	<b>Examiner Name</b>	G. S. Kishore
	<b>Attorney Docket Number</b>	58071-CON/RCE (47126)

Enclosed is a petition filed under 37 CFR 1.182 that requires a processing fee (37 CFR 1.17(f), (g), or (h)). Payment of \$ 400.00 is enclosed.

This form should be included with the above-mentioned petition and faxed or mailed to the Office using the appropriate Mail Stop (e.g., Mail Stop Petition), if applicable. For transmittal of processing fees under 37 CFR 1.17(i), see form PTO/SB/17i.

**Payment of Fees** (small entity amounts are NOT available for the petition fees).

☒ The Commissioner is hereby authorized to charge the following fees to Deposit Account No. 04-1105 :

☒ Petition fee under 37 CFR 1.17(f), (g) or (h) ☒ Any deficiency of fees and credit of any overpayments

Enclose a duplicative copy of this form for fee processing.

☐ Check in the amount of \$ \_\_\_\_\_ is enclosed.

☐ Payment by credit card (Form PTO-2038 or equivalent enclosed). Do not provide credit card information on this form.

**Petition Fees under 37 CFR 1.17(f): Fee \$400 Fee Code 1462**

For petitions filed under:

- § 1.53(e) – to accord a filing date.
- § 1.57(a) – to accord a filing date.
- § 1.182 – for decision on a question not specifically provided for.
- § 1.183 – to suspend the rules.
- § 1.378(e) – for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.
- § 1.741(b) – to accord a filing date to an application under § 1.740 for extension of a patent term.

**Petition Fees under 37 CFR 1.17(g): Fee \$200 Fee Code 1463**

For petitions filed under:

- § 1.12 – for access to an assignment record.
- § 1.14 – for access to an application.
- § 1.47 – for filing by other than all the inventors or a person not the inventor.
- § 1.59 – for expungement of information.
- § 1.103(a) – to suspend action in an application.
- § 1.136(b) – for review of a request for extension of time when the provisions of section 1.136(a) are not available.
- § 1.295 – for review of refusal to publish a statutory invention registration.
- § 1.296 – to withdraw a request for publication of a statutory invention registration filed on or after the date the notice of intent to publish issued.
- § 1.377 – for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.
- § 1.550(c) – for patent owner requests for extension of time in ex parte reexamination proceedings.
- § 1.956 – for patent owner requests for extension of time in inter partes reexamination proceedings.
- § 5.12 – for expedited handling of a foreign filing license.
- § 5.15 – for changing the scope of a license.
- § 5.25 – for retroactive license.

**Petition Fees under 37 CFR 1.17(h): Fee \$130 Fee Code 1464**

For petitions filed under:

- § 1.19(g) – to request documents in a form other than that provided in this part.
- § 1.84 – for accepting color drawings or photographs.
- § 1.91 – for entry of a model or exhibit.
- § 1.102(d) – to make an application special.
- § 1.138(c) – to expressly abandon an application to avoid publication.
- § 1.313 – to withdraw an application from issue.
- § 1.314 – to defer issuance of a patent.

_____ Signature	_____ Date
Lisa Swiszc Hazzard	44,368
Typed or printed name	Registration No., if applicable

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Dated: July 20, 2005

Signature: Lakeisha Bryant (Lakeisha Bryant)